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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,771	11/21/2000	Koji Hayashi	10449-028001	9013

26161 7590 02/19/2004

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225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 02/19/2004

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/717,771

Applicant(s)

HAYASHI, KOJI

Examiner

Aristotelis M Psitos

Art Unit

2653

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): reliance upon US patent to Tsukihashi.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-5 and 7-10.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Aristotelis M Psitos
Primary Examiner
Art Unit: 2653

Continuation of 2. NOTE: Applicants' amend the independent claim. This amendment alters the scope of the invention that was previously search. Under present USPTO practice such amendments are not normally entered at this time juncture. It is noted that:

- a) the examiner can nor readily find support for this new limitation in the originally filed application and hence an issue of new matter arises that must be concluded.

Furthermore, due to the change in the claimed limitation a new search is necessary as well as a review of the JP document. Furthermore, since applicants' have not perfected their foreign priority the EP document is still a valid reference (under 102 -a- see below). Again, such procedures are not entertained at the present time juncture under present USPTO practice.

Continuation of 5. Note: Applicants' arguments focus on the newly proposed unentered amendment, and hence do not overcome the rejections relying upon the EP document 0974966 as presented in paragraph 5, nor the remaining rejection(s) as previously presented in the final OA. With respect to the EP document, it is the examiners understanding that this document due to its publishing date is prior art under 102 (a), and hence is not overcome by applicants' statements with respect to common assignee at the time the invention was made.

With respect to the arguments against the JP document relied upon in paragraph 6 of the previous OA, there is nothing in the claim to limit it to a CD-R system. The JP document discloses various protocols and hence since no analysis with respect to the remaining protocols have been presented, the rejection is maintained. Additionally, with respect to applicants' arguments that the JP document may interrupt the data recording when the laser beam is at a high power, this does not preclude the reference - which by applicants' own admission also had a low power level to be used against the CLAIMED invention. If applicants' are implying that their system only works for a low power level and no other power, then the claims should recite such a limitation.